

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Susan D. WOOLF et al.

Serial No.: 09/455,805

Filed: December 7, 1999

For: SYSTEM AND METHOD FOR
ANNOTATING AN ELECTRONIC
DOCUMENT INDEPENDENTLY OF
ITS CONTENT

Atty. Docket No.: 003797.78802

Group Art Unit: 2176

Examiner: Nguyen, Maikhanh

Confirmation No.: 5591

DECLARATION UNDER 37 C.F.R. § 1.131

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We, SUSAN WOOLF, ANDREW BAIRD, SHENG JIANG, JOHN BEEZER, and DARRYL RUBIN, hereby declare¹ that:

- 1) We are named as joint inventors of the above-captioned patent application, U.S. Application Serial No. 09/455,805, and all claims presently pending therein;
- 2) I, SUSAN WOOLF, am presently employed by Microsoft Corporation (Microsoft) and have been since October 1995. Microsoft is the assignee of the above-identified application.
- 3) I, ANDREW BAIRD, was formerly employed by Microsoft. Microsoft is the assignee of the above-identified application
- 4) I, SHENG JIANG, am presently employed by Microsoft and have been since August 1996. Microsoft is the assignee of the above-identified application.

¹ Each numbered declaration is a joint declaration unless an individual reference has been made. In such a case, the referenced individual or individuals are making the numbered declaration.

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- 5) I, JOHN BEEZER, was formerly employed by Microsoft. Microsoft is the assignee of the above-identified application.
- 6) I, DARRYL RUBIN, am presently employed by Microsoft and have been since June 1986. Microsoft is the assignee of the above-identified application.
- 7) We were employed by Microsoft during development of the inventions in the above-identified patent application.
- 8) Prior to March 15, 1999, the earliest priority date of U.S. Patent No. 6,687,878, we reduced to practice the invention recited in claims 1-29 of the above-identified application.
- 9) Actual reduction to practice occurred prior to March 15, 1999, as evidenced by the documents entitled "Microsoft Patent Predisclosure Document" ("the Predisclosure Document") (dates redacted) prepared by Andrew Baird and Susan Woolf, a copy of which is attached as Exhibit A, "ePad Demo M2 Prototype Walk Through" ("the M2 Prototype Walk Through"), a copy of which is attached as Exhibit C, and "EPad M3 Demo Walk Through" ("the M3 Prototype Walk Through"), a copy of which is attached as Exhibit E. Each of these documents was prepared prior to March 15, 1999.
- 10) The M2 Prototype Walk Through and the M3 Prototype Walk Through were prepared by our Program Manager, Jonathan C. Cluts, in consultation with at least one of us. These documents relate to one or more software prototypes created by us to demonstrate and test the operation of different aspects of the invention. The statements in each walk through document represent an accurate description of the functional behavior and capabilities of the walk through document's associated prototype as of the creation date of each walk through document. Each walk through document was prepared prior to March 15, 1999. Since the M2 Prototype Walk Through and the M3 Prototype Walk Through provide no evidence of a creation date on their face, screen shots of dialog boxes of the properties of the electronic version of these documents has been included with the creation date

being prior to March 15, 1999 in Exhibit D and Exhibit F, respectively (dates redacted).

- 11) Regarding independent claim 1, Figure 1 of the Predisclosure Document is a screen shot of a software prototype demonstrating aspects of the invention, similar to the prototypes associated with the M2 Prototype Walk Through and the M3 Prototype Walk Through. Figure 1 of the Predisclosure Document demonstrates at least the actual reduction to practice of the “displaying a page of the electronic document” step (e.g., the arrow icons in the corners of the display), the “selecting an annotation mode” step (e.g., the annotation interface with the choices of ‘Ink’ ‘Highlight’ and ‘Erase’), and the “annotating parts of the currently displayed page” step (e.g., the highlighted text and the line to the left of the second paragraph of text), as recited in claim 1. Additionally, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of the “storing annotations” step (e.g. the “Tap on the Notes Directory Link” demo step), as recited in claim 1.
- 12) Regarding independent claim 10, Figure 1 of the Predisclosure Document demonstrates at least the actual reduction to practice of the “computer display device” and “document browser” elements (e.g., the arrow icons in the corners of the display), and the “computer software that permits the user to annotate” element (e.g., the annotation interface with the choices of ‘Ink’ ‘Highlight’ and ‘Erase,’ the highlighted text, and the line to the left of the second paragraph of text), as recited in claim 10. Additionally, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of the “computer input device that permits the user to indicate portions” element (e.g. the “Add some more notes by tapping,” “Clip the first paragraph,” and “Highlight the word judges” demo steps), as recited in claim 10.
- 13) Regarding independent claim 16, Figure 1 of the Predisclosure Document demonstrates at least the actual reduction to practice of the “displaying an electronic document page” step (e.g., the arrow icons in the corners of the display), and the “annotating parts of a currently displayed page” step (e.g., the highlighted text and

the line to the left of the second paragraph of text), as recited in claim 16. Additionally, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of the “storing annotations” step (e.g. the “Tap on the Notes Directory Link” demo step), as recited in claim 16.

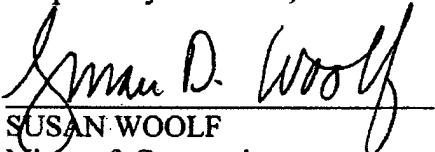
- 14) Regarding independent claim 29, Figure 1 of the Predisclosure Document demonstrates at least the actual reduction to practice of the “displaying a page of the electronic document” step (e.g., the arrow icons in the corners of the display), the “receiving a signal representing a selected annotation mode” step (e.g., the annotation interface with the choices of ‘Ink’ ‘Highlight’ and ‘Erase’), the “receiving a signal representing an annotation,” “determining an initial position,” “determining a width and trajectory,” and “displaying the annotation” steps (e.g., the highlighted text and the line to the left of the second paragraph of text), as recited in claim 29. Additionally, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of the “storing the annotation” step (e.g. the “Tap on the Notes Directory Link” demo step), as recited in claim 29.
- 15) Regarding dependent claims 2-5, 11-13, 17-19, and 24, Figure 1 of the Predisclosure Document demonstrates at least the actual reduction to practice of “using opaque markings,” “using a translucent hightlighting,” “produc[ing] a translucent annotation,” “using an erase highlighting,” “stor[sing] opaque annotations,” “stor[ing] translucent highlight annotations,” “stor[ing] erase annotations,” “creating an opaque annotation,” “creating an translucent annotation,” “erasing portions of previously created annotations,” and “an annotation mode selection menu” (e.g., the annotation interface with the choices of ‘Ink’ ‘Highlight’ and ‘Erase,’ the highlighted text, and the line to the left of the second paragraph of text), as respectively recited in these claims.
- 16) Regarding dependent claims 6 and 14, the M2 Prototype Walk Through demonstrates at least the actual reduction to practice of the use of a “stylus with a tablet computer system,” and a “flat panel display” (e.g. the ‘Talk about new Pen

control' message and the 'Tap on Start Button' action), as respectively recited in these claims.

- 17) Regarding dependent claims 7, 21-23, 25-28, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of "storing a separate stroke for each annotation," "annotations are stored in a data structure as strokes," "each stroke includes a stroke width and coordinates," and "annotations are stored as a bitmap image" (e.g. the "Create a note," "Create another note," "Tap on the Notes Directory Link," and "Follow a link" demo steps), as respectively recited in these claims.
- 18) Regarding dependent claims 8, 20, the M3 Prototype Walk Through demonstrates at least the actual reduction to practice of "retrieving previously stored annotations associated with the different document page" (e.g. the "Make a Bookmark," "Create a note," "Page forward," and "Tap on Bookmark" demo steps), as recited in these claims.
- 19) Regarding dependent claims 9, 15, the M2 Prototype Walk Through demonstrates at least the actual reduction to practice of "detecting a title change event," and "display[ing] the previously stored annotations on the different document page" (e.g. the "Click a few messages in the pinned page," "Click first message again," and "Write another note," actions), as respectively recited in these claims.
- 20) "Personal Viewers Information at your Fingertips. . . Literally," ("the PV Specification") prepared by Darryl Rubin prior to March 15, 1999 (dates redacted), a copy which is attached as Exhibit B, along with pages 1-2 of the Predisclosure Document, provide a context for understanding the reduction to practice demonstrated by Figure 1 of the Predisclosure Document, the M2 Prototype Walk Through, and the M3 Prototype Walk Through. Specifically, pages 49-53, 62-64, and 69-70 of the PV Specification, and the "Motivation for the Invention" and "Description of the Invention" sections on pages 1-2 of the Predisclosure Document, show that the prototypes worked for their intended purpose.

- 21) The attached Predisclosure Document has not been altered since it was originally prepared except for the redaction of references to dates. The attached PV Specification has not been altered since it was originally prepared except for the redaction of references to dates.
- 22) Each of us individually represent that we are over 18 years of age and of competent mind.
- 23) All statements made of our own knowledge are true and all statements made on information and belief are believed to be true; and further, these statements were made with the knowledge that willful, false statement so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001 and that such willful, false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

Respectfully submitted,



SUSAN WOOLF

Microsoft Corporation

January 13, 2006

Date

ANDREW BAIRD

Date

SHENG JIANG
Microsoft Corporation

Date

JOHN BEEZER

Date

DARRYL RUBIN
Microsoft Corporation

Date

Declaration Under 37 C.F.R. § 1.131
Reply to Office Action of October 31, 2005
Page 6 of 6

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Respectfully submitted,

SUSAN WOOLF
Microsoft Corporation



ANDREW BAIRD

Date

1/23/2006

Date

SHENG JIANG
Microsoft Corporation

Date

JOHN BEEZER

Date

DARRYL RUBIN
Microsoft Corporation

Date

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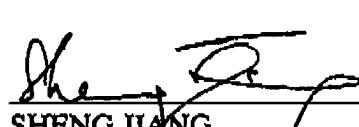
Respectfully submitted,

SUSAN WOOLF
Microsoft Corporation

Date

ANDREW BAIRD

Date


SHENG JIANG
Microsoft Corporation

Date

JOHN BEEZER

Date

DARRYL RUBIN
Microsoft Corporation

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Respectfully submitted,

SUSAN WOOLF
Microsoft Corporation

Date

ANDREW BAIRD

Date

SHENG JIANG
Microsoft Corporation

Date

JOHN BEEZER

Date

DARRYL RUBIN
Microsoft Corporation

Date

Jan. 26, 2006

Declaration Under 37 C.F.R. § 1.131
Reply to Office Action of October 31, 2005
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Respectfully submitted,

SUSAN WOOLF
Microsoft Corporation

Date

ANDREW BAIRD

Date

SHENG JIANG
Microsoft Corporation

Date

JOHN BEEZER

Date

DARRYL RUBIN
Microsoft Corporation

1/20/06

Date

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